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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/766,456	01/19/2001	John E. Cronin	ipCG-006	8647

7590 11/17/2005
ipCAPITAL GROUP, INC.
ATTEN: RYAN K. SIMMONS
400 CORNERSTONE DRIVE
SUITE 325
WILLISTON, VT 05495

EXAMINER

MOONEYHAM, JANICE A

ART UNIT PAPER NUMBER

3629

DATE MAILED: 11/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/766,456	Applicant(s) CRONIN, JOHN E.	
	Examiner Janice A. Mooneyham	Art Unit 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 11-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 11-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. This is in response to the applicant's communication filed on August 25, 2005, wherein;

Claims 1-9 and 11-52 are currently pending;

Claim 10 has been cancelled;

Claims 1-9 and 11-52 have been amended.

Response to Amendment

Oath/Declaration

2. The oath requirement is hereby withdrawn.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-9 and 11-55 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The applicant identifies the invention as a method for identifying a range of eligible aspects of an invention? What are eligible aspects?

The applicant claims "selecting a selected pair". What is a selected pair?

Claims 1-9 and 11-52 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. How does working through a ladder of abstraction identify one or more patent eligible aspects of an invention. How is the ladder of abstraction worked through?

It is not clear how to achieve the scope of the claimed invention, for example, applicant has not defined what a range of patent eligible aspects are. The specification does not define or identify what the applicant means by the term " a range of patent eligible aspects." How would one skilled in the art know how to identify a range of patent eligible aspects of an invention? How would one skilled in the art know how to iterate the steps to identify a range of patent eligible aspects are identified? In the detailed description of the invention (page 9 of the specification), the applicant identifies the invention as pertaining *to a business process of interviewing potential inventions [sic] from an individual or group, and documenting these inventions in a systematic way to define the potential intellectual property space that the inventions cover* (page 9, lines 4-6). The applicant then states that *the present invention pertains to an overall scanning invention process that comprises the general steps of; (1) a training means, (2) a facilitated interaction (discussion and recording information) which starts interviewing the invention at his/her invention level, (3) a facilitation means (discussion and recording information to change the level of abstraction of the inventions, (3) a*

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facilitated means (discussion and recording information) for changing the invention type, (5) a facilitated means (discussion and recording information) for changing the life cycle aspect, (6) a facilitated iteration means (discussion and recording information) for iterating the level of abstraction, invention type and life cycle, (7) a documentation means for capturing the invention and (8) a decision means to reduce the documented list of the invention down to a minimal group. The applicant then states that the following is a specific embodiment of each of the above-described steps, wherein the applicant identifies (1) a *training means*, (2) a *facilitation means for interviewing the inventor*, (3) *changing the level of abstraction* (4) a *facilitated means for changing the invention type wherein a facilitator asks questions*, (5) a *facilitated iteration means for iterating the level of abstraction, invention type and life cycle where applicant states that the facilitator interviews the invention [sic] by systematically changing the level of abstraction, the invention type and the life cycle* (page 17, lines 5-23). It is on page 17 (lines 9-11) that applicant claims to identify numerous ways to iterate through the steps and states the steps include the following: (a) *defining the starting level of abstraction, defining the invention type, and defining the life cycle* (b) *modifying the level of abstraction by holding constant the invention type and the life cycle* and (c) *iterating steps (a) and (b) until all levels of abstraction are exhausted.* In the body of the claims, applicant also claims a step of modifying the aspect. How does one modify the aspect? If you modify the aspect and then keep reiterating, how does one skilled in the art know when a range of patent eligible aspects of the invention has been identified? It is not clear how one identifies a range of patent eligible aspects of an invention by carrying

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out the iterating step. How does one determine which of the plurality of invention types to hold constant and how is it determined when all of the plurality of life cycle aspects have been exhausted? Furthermore, applicant claims generating a list containing at least some of the patent eligible aspects in the range of patent eligible aspects. Applicant has not defined how the at least some of the aspects are chosen to be included in the list. Thus, it would require undue experimentation for one skilled in the art to make or use the invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-9 and 11-52 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1-9 and 11-52 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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5. Claims 1-9 and 11-52 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. For a claimed invention to be statutory, it must produce a useful, concrete, and tangible result. Under the guidance of recent case law, the requirements of 35 U.S.C. 101 are met when "the practical application of the abstract idea produces a useful, concrete, and tangible result" (*State Street Bank & Trust Co. vs. Signature Financial Group, Inc.*, 47 USPQ2d 1596, 1601-02 (Fed. Cir. 1998)). In general, a method of identifying a range of patent eligible aspects of an invention is conceptually useful. However, the claims, as presently recited, do not appear to have a concrete result. In particular, it is unclear whether a method of "selecting a selected pair, working through a ladder of abstraction, iterating steps and generating a list" as recited in claims 1-9 and 11-52 can be repeatable and predictable (and thus, concrete), since it appears that the selection, working through the ladder of abstraction and generating the list are subject to human interaction and not a function of the claimed invention. Simply stated, when the subjective mental steps of a human are incorporated into the steps of the invention, what concrete result is achieved by the invention?

In light of the above, it is respectfully submitted that the claimed invention does not have a predictable or repeatable result, thus does not have a concrete result, and thus fails to recite the practical application of an abstract idea to satisfy the requirements of 35 U.S.C. 101.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

NOTE: The Examiner finds that because claim(s) 1-9 AND 11-52 are replete with 35 U.S.C. 112 1ST AND 2nd paragraph rejections, it is difficult if not impossible to completely construe claim scope at this time. However, in accordance with MPEP §2173.06 and the USPTO's policy of providing art rejections even though the claim(s) contain 35 U.S.C. 112 1ST AND 2nd paragraph rejections, the claims are construed and the art is applied as *much as practically possible*.

Claims 1-9 and 11-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over *A Model Software Petite Patent Act* by Mark Aaron Paley published in August, 1996 (hereinafter referred to as Paley).

Referring to Claims 1, 8, 13, 22, 29, 35 and 44:

Paley discloses a method for identifying a range of patent eligible aspects of an invention, the method comprising:

selecting one of an invention type (software) and selecting a life cycle aspect of the invention (page 18 Insufficient Lead Time to Recapture Software Development Costs);

identifying a range of patent eligible aspects (pages 9-13 What is patentable, What part of software is patentable, Does a software Algorithm qualify as a Patent Act Process).

Paley does not explicitly disclose generating a list.

However, the Examiner takes Official Notice that generating list of information is old and well known. For example, as one makes a determination of what projects need to be carried out, one usually list them. Furthermore, when one is evaluating ideas for the prospect of patenting the ideas, one generally would want to make a list of the ideas that one is interested in seeking a patent on.

Therefore, it would have been obvious to one of ordinary skill in the art to incorporate a list into the software analysis taught in Paley so as to know which aspects of the invention are worth pursuing a patent on and which ones are not.

Claims 1-7 and 18-19 depend on Claim 1, Claims 9, 11-12 and 20 depend on Claim 8, Claims 14-17 and 21 depend on Claim 13, Claims 23-28 depend on Claim 22, Claims 30-34 depend on Claim 29, Claims 36-39 depend on Claim 35, Claims 45-53 depend on Claim 44.

Response to Arguments

Applicant's arguments with respect to claims 1-9 and 11-52 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janice A. Mooneyham whose telephone number is (571) 272-6805. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Jan Mooneyham", with a long horizontal line extending to the right.

Jan Mooneyham
Patent Examiner
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